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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/903,743	07/31/1997	TIMOTHY MERRICK LONG	169.0568	2593

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FITZPATRICK CELLA HARPER & SCINTO  
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 NEW YORK, NY 10112

EXAMINER
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PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

35

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/903,743

Applicant(s)

LONG ET AL.

Examiner

CESAR B PAULA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,7,9-12,27-29,31-33,38 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This action is responsive to the RCE filed on 8/11/2003.

**This action is made Non-Final.**

2. In the amendment, claims 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-53 are pending in the case. Claims 1, 27-29, 31 and 38 are independent claims.

3. The rejections of claims 1, 3-4, 7, 9-12, 22, 27-29, 31, 38 42-53 under 35 U.S.C. 103(a) as being unpatentable over Nehab et al, hereinafter Nehab (Pat. # 6,029,182, 2/22/00, filed on 10/4/96), in view of Davis et al, hereinafter Davis (Pat. # 5,796,952, 8/18/98, filed on 3/21/97) have been withdrawn as necessitated by the amendment.

4. The rejections of claims 32-33 under 35 U.S.C. 103(a) as being unpatentable over Nehab, in view of Davis, and further in view of Hayashi et al (Pat. # 5,633,996, 5/27/97, filed on 11/8/94) have been withdrawn as necessitated by the amendment.

### ***Drawings***

5. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-4, 7, 9-12, 22, 27-29, 31, 38, 42-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al, hereinafter Nehab (Pat. # 6,029,182, 2/22/00, filed on 10/4/96).

Regarding independent claim 1, Nehab teaches the creation, by a stand alone *first application* of a personalized document. This document is created by collating and arranging various web pages of different newspapers articles into a single linear or continuous printable document. A “web reader” is used for monitoring url addresses or commands entered by a user while navigating a network web pages—*accessing plurality of hyper-text documents and formatting information*, and records them in a log for the later retrieval, and formatting into a single linear document of all the exact documents accessed by the user (c.3, L.15-c.4,L.67, c. 8,L.34-67, c.7,L.57-67). Nehab fails to explicitly disclose: *(a) monitoring a second application operating independently of said first application on said local machine, to identify the plurality of hyper-text documents accessed by the second application*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have monitored the second application--browser, because Nehab teaches the duplication of user’s selection criteria in

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clicking on hyperlinks in a web site (col. 8, lines 34-67). This provides the benefit of automatically, and interactively monitoring user's selection of hyperlinks, while interacting with only one application—the browser—instead of manually interacting with both the browser and the web reader to input user's browsing preferences.

Moreover, Nehab teaches the recording of selected hyperlinks portions or articles of webpages into a log using the articles' address or format information (c.3, L.15-c.4,L.67, c.8,L.34-67).

Furthermore, Nehab teaches the retrieving, and formatting of the various web pages using the address/location—*formatting information*, and/or articles of different newspapers into a single printable document, where the various newspapers are contiguously laid out (c.3, L.15-c.4,L.67, c.9,L.40-63).

Regarding claim 3, which depends on claim 1, Nehab teaches the creation, by a stand alone *first application*, of a personalized document by collating and arranging various web pages of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.9,L.40-62). Nehab fails to explicitly disclose: ....*the printable document is updated upon new hyper-text pages being accessed by the second application*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have updated the document, because Nehab teaches the duplication of user's selection criteria in clicking on hyperlinks in a web site (col. 8, lines 34-67). This provides the benefit of automatically, and interactively reproducing user's selection of hyperlinks, while avoiding time consuming manual update of the document.

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Regarding claim 4, which depends on claim 1, Nehab teaches a tracking program for the monitoring of url addresses or commands entered by a user while navigating a network web pages (c. 8,L.34-67)-- *....said steps are performed in a background mode relative to the user's access to the hyper-text documents.*

Regarding claim 7, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document of multiple columns (c.14, L.47, and c.16,L.1-67).

Regarding claim 9, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document with an index, and table of contents of the links to articles source links in the web pages (c.14, L.47-67, and c.15,L.20-c.16,L.67)--*....the printable document comprises a table of contents listing each hyper-text document .....*

Regarding claim 10, which depends on claim 1, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink references to the articles' sources --*....hyper-link index of at least one hyper link reference ...* (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

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Regarding claim 11, which depends on claim 10, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink cross-references to an index -  
-.... *each hyper-link reference in the printable document is tagged with a cross reference to a corresponding entry* ... (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding claim 12, which depends on claim 10, Nehab discloses including all hyperlink references of each article represented in the formatted document .... *said hyper-link index comprises all hyper-link references of each hyper-text* ... ..--(c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Claim 22 is directed towards a method for carrying out the steps found in claim 12, and therefore are similarly rejected.

Regarding independent claim 27, Nehab teaches the creation, by a stand alone *first application in a local computer*, of a personalized document by collating and arranging various web pages, from websites--*sources*, of different newspapers articles into a single linear or continuous printable document according to the size of the respective articles (c.3, L.15-c.4,L.67, c.13,L.12-67, fig. 9A). Nehab fails to explicitly disclose: *monitoring accesses by the second application to the plurality of documents in sequence*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have monitored the second application--browser, because Nehab teaches the duplication of user's selection criteria in clicking on hyperlinks in a web site (col. 8, lines 34-67). This provides the benefit of

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automatically, and interactively monitoring user's selection of hyperlinks, while interacting with only one application—the browser—instead of manually interacting with both the browser and the web reader to input user's browsing preferences.

Moreover, Nehab teaches the recording of selected hyperlinks of portions or articles of webpages into a log using the articles' address or format information (c.3, L.15-c.4,L.67, c.8,L.34-67).

Furthermore, Nehab teaches the retrieving, and formatting of the various web pages according the address/location—*formatting information*, and/or articles of different newspapers—*size information*-- into a single printable document, where the various newspapers are contiguously laid out (c.3, L.15-c.4,L.67, c.9,L.40-63).

Claim 28 is directed towards a computer system for carrying out the steps found in claim 27, and is similarly rejected.

Claim 29 is directed towards a computer readable medium for storing the steps found in claim 1, and is similarly rejected.

Claim 31 is directed towards a computer program product having a computer readable medium for storing the steps found in claim 1, and is similarly rejected.

Claim 38 is directed towards a method for forming a single printable documents for carrying out the steps found in claim 27, and is similarly rejected.



Claims 42-45 are directed towards a method for forming a single printable documents for carrying out the steps found in claim 1, and therefore are similarly rejected

Claims 46-47 are directed towards a computer program product having a computer readable medium for storing the steps found in claim 1, and therefore are similarly rejected.

Regarding independent claim 48, Nehab teaches the creation, by a stand alone first application of a personalized document by collating and arranging various web pages of different newspapers articles into a single linear or continuous printable document. A “web reader” is used for monitoring url addresses or commands entered by a user while navigating a network web pages—*accessing plurality of hyper-text documents and formatting information*, and records them in a log for the later retrieval, and formatting into a single linear document of all the exact documents accessed by the user (c.3, L.15-c.4,L.67, c. 8,L.34-67, c.7,L.57-67). Nehab fails to explicitly disclose: *displaying the list of the plurality of documents*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have displayed the list of documents, because this would have enabled the user to edit the list of documents according to user’s preferences, and taste.

Furthermore, Nehab teaches the a graphical user interface for editing the document list or profile, and formatting of the various web pages according to user’s dictates (c.9, L.35-67).

Claim 49 is directed towards a method for forming a single printable documents for carrying out the steps found in claim 48, and is similarly rejected.

Regarding claim 50, which depends on claim 48, Nehab teaches the creation of a personalized document by retrieving, collating—*compiling*-- and arranging various web pages of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.10,L.21-44).

Claims 51-53 are directed towards a computer program product having a computer readable medium for storing the steps found in claims 48-50, and therefore are similarly rejected.

8. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab, and further in view of Hayashi et al (Pat. # 5,633,996, 5/27/97, filed on 11/8/94).

Regarding claim 32, which depends on claim 7, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers into a single printable document (c.3, L.15-c.4,L.67). Nehab fails to explicitly disclose: *....maximizing the number of hyper-text documents on each page.....* However, Hayashi et al disclose: “....searching an area for display or printing to which the contents of the document can be laid out.....” (Col. 3, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Nehab, and Hayashi et al, because Hayashi et al teach above search of printable or displayable space the automatic layout of a structured document into a multicolumn document.

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Regarding claim 33, which depends on claim 32, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers into a single printable document (c.3, L.15-c.4,L.67). Nehab fails to explicitly disclose: *....determining if space exists on a page of the printable document.....if so, inserting the formatted hyper-text document.....* However, Hayashi et al disclose: “....searching an area for display or printing to which the contents of the document can be laid out.....” (Col. 3, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Nehab, and Hayashi et al, because Hayashi et al teach above search of printable or displayable space the automatic layout of a structured document into a multicolumn document.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-53 have been considered but are moot in view of the new ground(s) of rejection. The Applicant state that the claims are patentably distinct from the prior art (p.15,L.15-19). Upon a closer look at the claims and the prior art, the claims have been rejected as indicated above. The Applicants are referred to these rejections of the newly added features as noted above.

### ***Conclusion***

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nielsen (Pat. # 5,991,514).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The

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examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).**

CBP

12/3/03



STEPHEN S. HONG  
PRIMARY EXAMINER